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today was not written for publication and  
is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte SRIKAR RAO

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Appeal No. 2004-1235  
Application 09/845,643 <sup>1</sup>

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ON BRIEF

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MAILED

JUN 22 2004

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before PAK, KRATZ, and TIMM, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from  
the examiner's refusal to allow claims 1, 3 through 7, 9, 10 and  
13 through 18, which are all of the claims pending in the present  
application.

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<sup>1</sup> Application for patent filed March 30, 2001.

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APPEALED SUBJECT MATTER

Claims 1, 6, 13 and 17 are representative of the subject matter on appeal and a copy of these claims is appended to this decision.

PRIOR ART REFERENCES

The examiner relies on the following prior art references:

Buckman	4,386,774	Jun. 07, 1983
Kennedy	5,393,052	Feb. 28, 1995
Giglio	5,795,248	Aug. 18, 1998

REJECTION

The appealed claims stand rejected as follows:

- (1) Claims 1, 3, 6, 7, 13 and 16 through 18 under 35 U.S.C. § 103, as unpatentable over the disclosure of Giglio;
- (2) Claims 4, 5, 9, 10 and 15 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Giglio and Kennedy; and
- (3) Claim 14 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Giglio and Buckman.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments and evidence

advanced by both the examiner and the appellant in support of their respective positions. As a result of this review, we have made the determinations which follow.

We turn first to the examiner's rejection of Claims 1, 3, 6, 7, 13 and 16 through 18 under 35 U.S.C. § 103, as unpatentable over the disclosure of Giglio. We find that Giglio teaches a golf accessory caddy (10) comprising a clip member (20) and a body member (12) forming a generally U-shape design corresponding to the claimed golf ball marker holder in the form of a clip. See Figures 1-3, column 2, lines 41-50 and column 3, lines 2-5. We find that Giglio teaches that the clip member (20) can be molded from plastic and can be integrally formed with the body member (20).<sup>2</sup> See column 2, line 67 to column 3, line 2. We find that Giglio teaches that the body member (20), which can also be molded from plastic, defines a cylindrical ball marker storage cavity (14) having an adhesively attached ball marker retaining magnet (16) and two tee holding cavities (18). See column 2, lines 51-65. We find that Giglio teaches that its golf ball marker (24) is "a substantially circular disk shaped section

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<sup>2</sup> Giglio teaches that its caddy can be made of a monolithic structure having two portions (body (20) and clip (12)) forming the legs of a generally U-shaped member as required by claims 13 and 17.

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of magnetically attractable steel that is sized to fit within [the] ball marker storage cavity..." and contains any desired identifying indicia, such as the name of a golf equipment manufacturer, on its top surface. See column 3, lines 23-31.

We note that the golf accessory caddy (10) described in Giglio is not free from the tee holding cavities as required by the claims on appeal. However, we concur with the examiner that the elimination of the tee holding cavities and their known attendant functions from the golf accessory caddy (10) would have been *prima facie* obvious to one of ordinary skill in the art inasmuch as the usefulness of the golf accessory caddy (10) is readily apparent to those skilled in the art even in the absence of the tee holding cavities. See *In re Thompson*, 545 F.2d 1290, 1294, 192 USPQ 275, 277 (CCPA 1976); *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975); *In re Wilson*, 377 F.2d 1014, 1016-17, 153 USPQ 740, 742 (CCPA 1967). That is, one of ordinary skill in the art would readily recognize that the golf accessory caddy (10), even without the tee holding cavities, is useful as an effective carrier for a golf ball marker and a golf glove.

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The appellant defines the size of his golf ball marker holder or the gap between their generally U-shape golf ball marker holder in terms of a function, i.e., capable of being attached to a shoe, in claims 1, 13 and 17. The appellant then argues that the golf accessory caddy (10) described in Giglio is not sized or shaped for attachment to a shoe. We do not agree.

As stated in *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997):

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, . . . 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. See also *in re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, . . . 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

Here, we find that the generally U-shaped caddy described in Giglio is shown to be much smaller than a golf glove and can be attached to the belt or the waistband of a golfer using the gap (38) therein. See Figure 2 in conjunction with column 3, lines 5-7. Thus, we concur with the examiner that there is a reasonable basis to believe that the generally U-shaped caddy described in Giglio is capable of being attached to a shoe. *Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1432. We find nothing in the record which contradicts this finding. That is, the appellant has not supplied any objective evidence to demonstrate that the generally U-shaped caddy described in Giglio is not capable of being attached to a shoe.

With respect to claim 17, the appellant argues that Giglio does not teach the claimed "means for releasably fixing a ball marker to the outer portion." See the Brief, page 5. According to the appellant (the Brief, pages 5 and 6), pursuant to 35 U.S.C. § 112, sixth paragraph, this means-plus-function language includes "the disclosed indentation 16 and recessed cavity 17 with a depth less than the thickness of the marker so

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that a portion of the marker extends from the recess and facilitates, with indentation 16, removal of the marker from the recess." We do not agree.

As is apparent from the specification, the appellant fails to clearly link the claimed means-plus-function language with the disclosed recessed cavity, indentation and depth. Compare *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997). One of ordinary skill in the art, reading the appellant's specification, can, therefore, reasonably conclude that the disclosed recessed cavity alone corresponds to the claimed means-plus-function language. This interpretation is especially appropriate in this case since the claim language must be given the broadest reasonable interpretation during the prosecution of a patent application. Thus, we concur with the examiner that Giglio, by disclosing a cylindrical ball marker storage cavity (14) useful for "releasably fixing a ball marker," teaches the claimed means-plus-function limitation.

It follows that Giglio would have rendered the subject matter defined by claims 1, 3, 13 and 16 through 18 obvious within the meaning of 35 U.S.C. § 103. Accordingly, we affirm

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the examiner's decision rejecting claims 1, 3, 13 and 16 through 18 under 35 U.S.C. § 103.

However, the examiner's Section 103 rejection of claims 6 and 7 is on different footing. Although the generally U-shaped caddy described in Giglio is capable of being attached to a shoe, we find no motivation or suggestion to combine Giglio's caddy with a shoe as indicated by the appellant at page 4 of the Brief. On this record, the examiner has not explained why one of ordinary skill in the art would have been led to combine Giglio's caddy with a shoe, knowing the shape of Giglio's caddy (i.e., "the end bent at an angle" which would have expected to cause discomfort to a person wearing a shoe).

It follows that Giglio would not have rendered the subject matter defined by claims 6 and 7 obvious within the meaning of 35 U.S.C. § 103. Accordingly, we reverse the examiner's decision rejecting claims 6 and 7 under 35 U.S.C. § 103.

We turn next to the examiner's rejection of claims 4, 5, 9, 10 and 15 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Giglio and Kennedy. The disclosure of Giglio is discussed above. The Giglio does not mention employing "at least



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one indentation positioned adjacent to said circular recessed cavity" as required by claims 4 and 15.

To remedy this deficiency, the examiner relies on the disclosure of Kennedy. See the final Office action dated May 14, 2003, pages 2 and 3. The examiner finds, and the appellant does not dispute, that "Kennedy reveals a golf mark retaining device including a recess (16) and an indentation (60) for assisting in grasping the ball marker." Compare the final Office action dated May 14, 2003, page 3, with the Brief in its entirety.

Although Giglio also discloses a feature for "assisting in grasping the ball marker," we concur with the examiner that one of ordinary skill in the art would have been led to use either golf ball marker removing feature in Giglio's caddy, motivated by a reasonable expectation of successfully facilitating the removal of the golf ball marker from the circular recessed cavity therein.

It follows that the combined teachings of Giglio and Kennedy would have rendered the subject matter of claims 4, 5 and 15 obvious to one of ordinary skill in the art withing the meaning of 35 U.S.C. § 103. Accordingly, we affirm the examiner's decision rejecting claims 4, 5 and 15 under 35 U.S.C. § 103.

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However, the examiner's Section 103 rejection of claims 9 and 10 is on different footing. Claims 9 and 10 include the limitations of claims 6 and 7 since they are dependent on claims 6 and 7. However, Kennedy does not remedy the deficiencies indicated *supra*.

As such, the combined teachings of Giglio and Kennedy would not have rendered the subject matter of claims 9 and 10 obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. Accordingly, we reverse the examiner's decision rejecting claims 9 and 10 under 35 U.S.C. § 103.

We turn next to the examiner's rejection of claim 14 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Giglio and Buckman. The disclosure of Giglio is discussed above. Giglio does not mention that "the recess has a depth less than the thickness of the ball marker so that the ball marker protrudes slightly past the outer portion surface" as required by claim 14.

To remedy this deficiency, the examiner relies on the disclosure of Buckman. See the final Office action dated , page 3. The examiner finds, and the appellant does not dispute,

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that "Buckman discloses a golf ball marker and carrying tool comprising a recess (4) sized for receiving a ball marker (7) and magnet (6). Note Figure 2 which shows the ball marker protruding slightly past the outer surface of the recess." Compare the Answer, page 3, with the Brief in its entirety. The examiner finds, and the appellant does not dispute, that this feature facilitates the removal of the ball marker. Compare the Answer, page 3, with the Brief in its entirety.

Although Giglio also discloses a feature for facilitating the removal of the ball marker, we concur with the examiner that one of ordinary skill in the art would have been led to use either ball marker removing feature in Giglio's caddy, motivated by a reasonable expectation of successfully facilitating the removal of the golf ball marker from the circular recessed cavity therein.

It follows that the combined teachings of Giglio and Kennedy would have rendered the subject matter of claim 14 obvious to one of ordinary skill in the art withing the meaning of 35 U.S.C. § 103. Accordingly, we affirm the examiner's decision rejecting claim 14 under 35 U.S.C. § 103.


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## CONCLUSION

In view of the foregoing, we affirm the examiner's decision rejecting claims 1, 3 through 5, and 13 through 18 under 35 U.S.C. § 103, but reverse the examiner's decision rejecting claims 6 through 10 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED - IN - PART

  
CHUNG K. PAK

CHUNG K. PAK  
Administrative Patent Judge

Pets Fr Kids

PETER F. KRATZ  
Administrative Patent Judge

BOARD OF PATENT  
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INTERFERENCES

*Catherine Timm*  
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APPENDIX  
Claims 1, 6, 13 and 17

1. A golf ball marker and holder comprising:

a clip that is free of golf tee attachment surfaces, sized for attachment to a shoe, and defining a circular recessed cavity sized and positioned to receive a portion of said marker;

a marker comprising a disk that is free of an appendage and having a solid face with an image at least partially covering a central portion and being removably attached to said clip;

one of said clip and said marker having a ferrous portion; and

an other of said clip and said marker having a magnetic portion.

6. A golf ball marker and shoe comprising:

a marker comprising a disk that is free of an appendage and having a solid face with an image at least partially covering a central portion and being removably attached to a clip;

one of said clip and said marker having a ferrous portion;

an other of said clip and said marker having a magnetic portion; and said clip defining a circular recessed cavity sized and positioned to receive a portion of said marker, being free of golf tee attachment surfaces and being clipped to a shoe.

13. A ball marker holder comprising:

a monolithic strip having two portions forming the legs of a generally U-shaped member,

the portions cooperating to form a space adapted to receive a portion of the wall of a golf shoe with one portion extending inside the golf shoe and the other outer portion extending along the outer wall of the golf shoe,

the outer portion having a recess sized to receive a ball marker.

17. A ball marker holder comprising:

a monolithic strip having two portions forming the legs of a generally U-shaped member,

the portions cooperating to form a space adapted to receive a portion of the wall of a golf shoe with one portion extending inside the golf shoe and the other outer portion extending along the outer wall of the golf shoe,

means for releasably fixing a ball marker to the outer portion.